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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/993,856	11/14/2001	Margaret M. Jahn	19603/3391 (CRF D-2702A)	7990
7590 01/08/2004			EXAMINER	
Michael L. Goldman, Esq. NIXON PEABODY LLP Clinton Square P.O. Box 31051 Rochester, NY 14603-1051			KUBELIK, ANNE R	
			ART UNIT	PAPER NUMBER
			1638	

DATE MAILED: 01/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/993,856

Applicant(s)

JAHN, MARGARET M.

Examiner

Anne R. Kubelik

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 October 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,18-22,39-43,45,62-65 and 67-73 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,18-22,39-43,45,62-65 and 67-73 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 5) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

1. Claims 1, 18-22, 39-43, 45, 62-65 and 67-73 are pending.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. The rejection of claims 1, 6-17, 27-38 and 50-61 under 35 U.S.C. 112, first paragraph, as containing subject matter that was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention is withdrawn in light of cancellation of claims drawn to methods of producing gummy blight resistant *C. melo* seed by crossing plants that have the resistance genes *Gsb1*, *Gsb2*, *Gsb4*, *Gsb5* or *gsb3*, and seed and plants thereby produced.
4. The rejection of claims 1-8, 10-12, 14-16, 18-20, 22-29, 31-33, 35-37, 39-41, 43-52, 54-56, 58-60, 62-63 and 65-66 under 35 U.S.C. 102(a) as being anticipated by Zuniga et al (1999, Plant Dis. 83:1105-1107) taken with the evidence of the instant specification and the rejection of claims 67-73 under 35 U.S.C. 102(a) as anticipated by or, in the alternative, under 35 U.S.C. 103 as obvious over Zuniga et al are withdrawn in light of the Declaration of Margaret Jahn stating that T.L. Zuniga, J.P. Jantz and T.A. Zitter did not invent the subject matter of the claims.
5. The rejection of claims 1, 18-20, 22, 39-41, 43, 45 62-63 and 65 under 35 U.S.C. 102(b) as being anticipated by each of Prasad et al (1967, Amer. Hort. Sci. 91:396-400) and Norton et al (1989, HortSci. 24:709-711) taken with the evidence of the instant specification is withdrawn in light of Applicant's amendment of the claims.
6. The rejection of claims 1, 18-22, 39-43, 45 and 62-65 under 35 U.S.C. 103(a) as being obvious over each of Prasad et al (1967, Amer. Hort. Sci. 91:396-400) and Norton et al (1989,

HortSci. 24:709-711) in view of Trulson et al (1986, Plant Science 4:35-43) is withdrawn in light of Applicant's amendment of the claims.

Claim Rejections - 35 USC § 112

7. Claims 1, 18-22, 39-43, 45, 62-65 and 67-73 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter that was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Neither the instant specification nor the originally filed claims appear to provide support for the phrase "commercially appealing". Thus, such a phrase constitutes NEW MATTER. In response to this rejection, Applicant is required to point to support for the phrase or to cancel the new matter.

8. Claims 1, 18-22, 39-43, 45, 62-65 and 67-73 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter that was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The rejection is repeated for the reasons of record as set forth in the Office action mailed 3 April 2003, as applied to claims 1, 3-5, 22, 24-26, 45, 47-49 and 67-73. Applicant's arguments filed 6 October 2003 have been fully considered but they are not persuasive.

Applicant urges that *Cucumis melo* plants Cornell ZPPM 339, TAM Uvalde, UC Topmark, Oro Rico, Galia type, Ananas type, PI 157082, PI 511890, PI 482399, PI 482398 and

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PI 140471 are either commercially available or available thorough the U.S. National Germplasm System (response pg 7-8).

This is not found persuasive because Applicant did not provide evidence that these plants were so available. Additionally, there is no guarantee that such plants will be available for a period of 30 years or 5 years after the last request or for the enforceable life of the patent, whichever is longer.

See MPEP 2404, which states :

Ex parte Humphreys, 24 USPQ2d 1255 (Bd. Pat. App. & Int.1992), held that the only manner in which applicants could satisfy their burden of assuring public access to the needed biological material, and, thereby, compliance with the enablement requirement of 35 U.S.C. 112, was by making an appropriate deposit. The fact that applicants and other members of the public were able to obtain the material in question from a given depository prior to and after the filing date of the application in issue did not establish that upon issuance of a patent on the application that such material would continue to be accessible to the public.

Applicant urges that the plant line designated NY 01-190-3R, -7L, -9L was deposited in accordance with the Budapest Treaty (response pg 8).

This is not found persuasive because the statement that all restrictions upon availability to the public will be irrevocably removed upon granting of the patent is missing.

9. Claims 1, 18-22, 39-43, 45, 62-65 and 67-73 remain rejected under 35 U.S.C. 112, first paragraph, as containing subject matter that was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The rejection is repeated for the reasons of record as set forth in the Office action mailed 3 April 2003, as applied to claims 1-66. Applicant's arguments filed 6 October 2003 have been fully considered but they are not persuasive.

Applicant urges that the amendments overcome this rejection (response pg 8).

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This is not found persuasive. It is not clear that Cornell ZPPM 339, TAM Uvalde, UC Topmark, Oro Rico, PI 157082, PI 511890, PI 482399, PI 482398 or PI140471 are homozygous inbred lines; thus, deposit of seeds from these lines will not define progeny of crosses between any two of these plants. Galia type and Ananas type melons are not inbred lines, but are simply types of plants and can be any of numerous different genotypes; thus, progeny of crosses of these plants with each other or any of the above plants cannot be defined. Furthermore, the second *C. melo* plant used in the method of claims 19-21 is not described in any manner. Neither the plants required by each of the steps, nor the plants that are produced by the process are defined by genomic structure or by phenotypic characteristics. Therefore, plants produced by crosses among these plants are not described, and the claimed invention lacks an adequate written description.

10. Claims 1, 18-22, 39-43, 45, 62-65 and 67-73 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter that Applicant regards as the invention. Dependent claims are included in all rejections. The rejection is modified from the rejection set forth in the Office action mailed 3 April 2003, as applied to claims 19-21, 42, 44, 64 and 66-73, due to amendment of the claims. Applicant's arguments filed 6 October 2003 have been fully considered but they are not persuasive.

Claims 20-21 remain indefinite because there are no clear positive method steps.

Applicant urges that the rejection is traversed in view of the amendments (response pg 8).

This is not found persuasive. The method steps of the traditional plant breeding techniques in claim 20 and the tissue culture techniques of claim 21 are not clearly defined. It is

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uncertain for each of the recited techniques what steps they would be comprised of, how many generations of crosses would be incorporated in the method, and what parent plants would be used for each cross.

Claim 67 is indefinite in its recitation of “(composite)”. It is unclear what this term means. Does it mean that the breeding line NY 01-190-3R, -7L, -9L is not composed of genetically uniform plants but is a mixture, or “composite”, of genetically different plants? If that is the case, have 2500 seeds of each genotype been deposited?

Applicant urges that the rejection is traversed in view of the amendments (response pg 8).

This is not found persuasive because no amendments were made to address this rejection.

The following rejection is new, due to amendment of the claims:

Claims 1, 18-19, 22, 39, 45, 67-68 and 73 are indefinite in their recitation of “commercially appealing”. It is unclear what traits are considered commercially appealing - Large fruit? Small fruit? Smooth skin? Netted skin? The phrase is not defined by the specification.

In claim 42, is Applicant claiming a tissue culture or the plant regenerated from it? If the former, it is suggested that “are” in line 4 be replaced with --can be --

In claims 64 and 71, line 4, “are capable of regeneration” should be replaced with --can be regenerated--.

Claim Rejections - 35 USC § 103

11. Claims 1, 18-20, 22, 39-41, 43, 45, 62-63 and 65 remain rejected under 35 U.S.C. 103(a) each of Prasad et al (1967, Amer. Hort. Sci. 91:396-400) and Norton et al (1989, HortSci.

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24:709-711) in view of each of Kalb et al (1984, J. Amer. Hort. Sci. 109:411-415) and Zhang et al (1997, HortSci. 32:117-121) and Applicant's admission. The rejection is repeated for the reasons of record as set forth in the Office action mailed 3 April 2003, as applied to claims 1-20, 22-41, 43-63 and 65-66. Applicant's arguments filed 6 October 2003 have been fully considered but they are not persuasive.

Applicant urges that the claims, as amended, require that the progeny plants be "commercially appealing" and there is no evidence that such a plant is produced (response pg 11).

This is not found persuasive. Given that the phrase is not defined, any plants produced would be appealing for some commercial purpose or another.

Applicant urges that the purpose of Prasad was to determine the mode of inheritance of the gummy stem blight resistance trait in PI 140471, and Prasad does not teach or suggest that crossing PI 140471 with any other plant would yield a "commercially appealing" plant.

Applicant also urges that Norton does not teach or suggest that crossing PI 140471 with any other plant would yield a "commercially appealing" plant (response pg 11).

This is not found persuasive. Given that the phrase is not defined, any plants produced would be appealing for some commercial purpose or another.

Applicant urges that Zhang does not discuss or use any breeding studies or crosses (response pg 11).

This is not found persuasive. Zhang et al suggest using the lines they have identified as having resistance in breeding programs (pg 120, column 3, paragraph 4).

Applicant urges that Kalb does not discuss using a gummy blight resistance melon to impart gummy stem blight resistance in plants (response pg 11).

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This is not found persuasive. Kalb et al is not used in this rejection for teaching using a gummy blight resistance melon to impart gummy stem blight resistance in plants, but instead is used because it teaches that the fruit qualities UC Topmark and other *C. melo* varieties could bring to breeding programs (Kalb et al, pg 413, paragraph spanning the columns).

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

12. Claims 21, 42 and 64 are rejected under 35 U.S.C. 103(a) as being unpatentable over Prasad et al (1967, Amer. Hort. Sci. 91:396-400) and Norton et al (1989, HortSci. 24:709-711) in view of each of Kalb et al (1984, J. Amer. Hort. Sci. 109:411-415) and Zhang et al (1997, HortSci. 32:117-121) as applied to claims 1, 18-20, 22, 39-41, 43, 45, 62-63 and 65 above, and further in view of Trulson et al (1986, Plant Science 4:35-43).

The teachings of Prasad et al and Norton et al in view of each of Kalb et al and Zhang et al are discussed above. Prasad et al and Norton et al in view of each of Kalb et al and Zhang et al does not disclose the use of tissue culture techniques in the breeding program or tissue culture of the plants they produced.

Trulson et al teach tissue culture and plant regeneration in *C. melo* (pg 39, right column, paragraph 3)

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to modify the method of producing gummy blight resistant *C. melo* hybrid seed as taught by Prasad et al and Norton et al in view of each of Kalb et al and Zhang et al, to use tissue

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culture techniques as described in Trulson et al in the breeding program. One of ordinary skill in the art would have been motivated to do so because of the importance of tissue culture techniques in plant breeding (Trulson et al, pg 42, right column, paragraph 3).

Claim Rejections - 35 USC § 102 - 35 USC § 103

13. Claims 67-73 remain rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103 as obvious over each of Prasad et al (1967, Amer. Hort. Sci. 91:396-400) and Norton et al (1989, HortSci. 24:709-711). The rejection is repeated for the reasons of record as set forth in the Office action mailed 3 April 2003. Applicant's arguments filed 6 October 2003 have been fully considered but they are not persuasive.

Applicant urges that NY 01-190-3R, -7L, -9L was derived from crosses involving the *C. melo* plants recited in claims 1, 22 and 45 and Prasad and Norton do not teach or suggest those crosses (response pg 12).

This is not found persuasive. The specification does not describe the parentage of NY 01-190-3R, -7L, -9L. A prior art plant having the same characteristics as the claimed plant would anticipate the claimed plant even if made by a different method (i.e., using a different parent plant). Furthermore, the rejection is made because the Examiner cannot determine whether the prior art plant possesses the unrecited characteristics. The Examiner does not have sufficient facts to determine whether the *C. melo* plants and seeds are inherently the same. In addition, the Examiner cannot conclude that the claimed subject matter would have been obvious since it cannot be determined whether the soybean plants differ. Where the prior art product seems to be identical, except that the prior art is silent to a characteristic or property claimed,

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then the burden shifts to Applicant to provide evidence that the prior art would neither anticipate nor render obvious the claimed invention. See *In re Best* 195 USPQ 430, 433 (CCPA 1977).

Conclusion

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anne R. Kubelik, whose telephone number is (703) 308-5059. The examiner can normally be reached Monday through Friday, 8:30 am - 5:00 pm. Sometime in January 2004, the examiner's phone number will change to 571-272-0801.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amy Nelson, can be reached at (703) 306-3218. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to Customer Service at (703) 308-0198.

Anne R. Kubelik, Ph.D.

December 15, 2003



**AMY J. NELSON, PH.D.
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600**